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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/483,062	01/14/2000	David B. Quinones	AND1P418	7850

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EXAMINER

EL HADY, NABIL M

ART UNIT	PAPER NUMBER
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2154

18

DATE MAILED: 05/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

224

Office Action Summary

Application No.

09/483,062

Applicant(s)

QUINONES ET AL.

Examiner

Nabil M El-Hady

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12 is/are allowed.
- 6) ☒ Claim(s) 13-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. Claims 1-18 are pending in this application.
2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 14, 15, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - A. The following phrases are not clearly understood:
 - a) "an of the application service provider ability", claim 14, line 2.
 - B. The following terms lack antecedent basis:
 - a) "the application service provider", claim 14, line 2;
 - b) "the predefined rules", claim 15, line 2;
 - c) "the upgrades", claim 18, line 1.
4. Claims 1-12 are allowable.
5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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6. Claims 13-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cheng et al. (USPN 6,151,643), hereafter "Cheng" in view of Cooper et al. (US 5,809,282), hereafter "Cooper".

7. As to claims 13, and 15, Cheng discloses the invention substantially as claimed including a system for improving an existing application infrastructure of an application service provider (abstract). The system comprising logic for prompting a user to identify at least one aspect of an existing application infrastructure utilizing a network (col. 18, 16-53); logic for receiving the identification of the at least one aspect of the existing application infrastructure utilizing the network (col. 19, lines 8-11); logic for analyzing the at least one aspect of the existing application infrastructure using information stored in a database (col. 7, lines 54-61); and logic for proposing improvements to the existing application infrastructure based on the analysis utilizing the network (col. 7, lines 62-64).

8. Cheng does not necessarily disclose using spreadsheet in the database. However, spreadsheet is well known in the art to be used as an automated table, and it would be obvious to one skilled in the art at the time of the invention to relate Cheng's database tables (col. 10, lines 63-67, and Fig. 8) to perform as a spreadsheet.

9. Cheng does not explicitly disclose a knowledge database. However, the use of a knowledge database to includes knowledge of experts in the form of rules and regulation is not new in the art. Cooper, for example, discloses the use of knowledge database to input various aspects of applications. It would be obvious to one skilled in the art at the time of the invention to combine the teachings of Cheng and Cooper because Cooper Knowledge database would

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enhance the functionality of Chang's system by providing knowledge base for selecting modification options and making informed decisions with predefined rules (see, Cooper, col. 2, lines 60-67; and col. 3, lines 13-30).

10. As to claim 14, Cheng discloses the ability to deliver applications over the network (col. 6, lines 11-30).

11. As to claim 16, Cheng discloses assessing results of the analysis and providing the user with the assessment (col. 7, lines 54-67, and col. 8, lines 1-7).

12. As to claim 17, Cheng discloses querying the user to identify the at least one aspect of the existing application infrastructure (Fig. 17a-17-d).

13. As to claim 18, Cheng discloses adding components of the existing application infrastructure that are currently absent (col. 7, lines 62-67, and col. 8, lines 1-20).

14. Applicant's arguments filed 4/21/2004 have been fully considered but they are not persuasive.

15. In the remarks, applicants argued in substance that (1) the references fail to teach or suggest translating an application infrastructure aspect into a common structure and analyzing the common structure, (2), the references fail to teach or suggest identifying upgrades to an application infrastructure of an application service provider.

16. Examiner respectfully traverses applicants' remarks.

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17. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 2, 2004



Nabil El-Hady, Ph.D, M.B.A.
Primary Patent Examiner
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